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Appl. No. 09/620,803
Amdt. Dated March 2, 2006
Reply to Office Action of December 2, 2005

Docket No. WV00036
Customer No. 22917

REMARKS/ARGUMENTS

Claims 33 and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. The examiner states that these claims are omnibus type claims.

According to MPEP § 2173.05(r), an omnibus claim is shown in exemplary form as “[t]he device as substantially shown and described.” More to the point, the P.T.O. Board of Pat.App. & Int. held in 1993 in *Ex parte Fressola* that omnibus claims that refer to a figure or the specification are indefinite per 35 U.S.C. § 112, second paragraph. *Ex Parte Fressola*, 27 U.S.P.Q.2d 1608 (1993).

Applicants submit that Claims 33 and 52 as written neither refers to the drawings nor the specification. Applicants further submit that the claims *do in fact* point out what is to be included. For example, Claim 33 requires

providing ... A, B, one or more of C and D;
selecting ; and
displaying ... said performance information being one or more of the following A, B, and C

and Claim 52 requires

a computer including A, B, and one or more of C and D;
a selector; and
a display ... said performance information being one or more of the following A, B, and C.

Applicants respectfully submit that that Examiner may be confusing omnibus type claims with claim breadth. According to MPEP § 2173.04, “[b]readth of a claim is not to be equated with indefiniteness.” As such, the Examiner should not reject Claims 33 and 52 under 35 U.S.C. 112 as being omnibus type claims. Applicants respectfully submit that the claims as written are

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proper per 35 U.S.C. § 112, second paragraph. Applicants respectfully request reconsideration of the objection.

The Examiner has rejected Claim 52 as being unclear because it is unclear how the computer system includes actual performance measurements. The Examiner is respectfully reminded that the claims must be read in light of the specification and the specification teaches that the computer may require another measurement device for taking measurements (see pages 8-10, 25, 28-31) or may take measurements by itself (see pages 16, 25). Further, measurements are also described in co-pending application U. S. Patent Application Serial No. 09/221,985 (now issued as U.S. Patent No. 6,442,507) which was incorporated by reference into the present application. As such, Applicants respectfully request reconsideration of this rejection.

The Examiner has rejected Claim 52 as being unclear because it is unclear how the selector is able to select specific components in a plurality of system components. The Examiner is reminded that the Claim must be read in light of the specification and the specification teaches that in one embodiment, "[u]sing a mouse or other input positioning device the designer may select and view various communication hardware device models that represent actual communication system components from a series of pull-down menus." Applicants' specification, pages 14-15, 24.

Claims 35-39, 41-42, 54-58, 60-61 and 74 are rejected as reciting a limitation to "said one or more icons" that has insufficient antecedent basis. Claim 38 is rejected as reciting a limitation to "the functionality of one or more watch points" that has insufficient antecedent basis. Claim 39 is rejected as reciting a limitation to "the functionality of a grid of watch points" that has insufficient antecedent basis. Claim 57 is rejected as reciting a limitation to "the functionality of one or more watch points" that has insufficient antecedent basis. Claims 62-63 are rejected as

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reciting a limitation to "the group consisting of..." that has insufficient antecedent basis. Claim 66 is rejected as reciting a limitation to "the measurement device group consisting of..." that has insufficient antecedent basis.

Applicants respectfully apologize for these errors and have made the necessary amendments to the claims to overcome these rejections under 35 U.S.C. § 112.

The Applicants believe that the subject application, as amended, is in condition for allowance. Such action is earnestly solicited by the Applicants.

Please charge any fees that may be due to Deposit Account 502117, Motorola, Inc.

Respectfully submitted,

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Attachments